

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURTIS OHRT

Appeal 2007-3163
Application 09/504,978
Technology Center 3600

Decided: October 10, 2007

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT,
and ST. JOHN COURTEMAY III, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-23. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal employs a computer in a client/server environment to calculate rates for insurance products. (Specification 1.)

More specifically, the invention includes a product application or component object that requests a rate from a rate calculating software component and can supply data needed for the calculation. At least one support software component and at least one protocol stack facilitate communication among components. (*Id.* 18.)

B. ILLUSTRATIVE CLAIMS

Claims 1 and 16, which further illustrate the invention, follow.

1. A product rate calculation system comprising:

a product application operable to provide product information to and receive consumer information from a user, and further operable to send a call to a product rate calculation software component;

a first support software component operable to receive the call from the product application; and

a first protocol stack operable to process the call into a protocol for transmission over a communication link.

16. A method calculating a product rate comprising:

receiving a request for a product rate from a user;

converting the request for a product rate into a call to a product rate calculation software component;

sending the call to a product rate calculation software component to a first software component;

receiving, at the first support software component, the call to a product rate calculation software component;

processing the call to a product rate calculation software component into protocol for transmission over a communication link; and

transmitting the call to a product rate calculation software component over the communication link.

C. REJECTIONS

Claims 1-23 stand rejected under 35 U.S.C. § 112, ¶ 2, as indefinite. Claims 1-3, 5, 6, and 12-23 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,523,9432 ("Tyler") and U.S. Patent No. 5,689,650 ("McClelland"). Claim 4 stands rejected under § 103(a) as obvious over Tyler; McClelland; and U.S. Patent No. 6,026,404 ("Adunuthula"). Claims 7, 9, and 11 stand rejected under § 103(a) as obvious over Tyler; McClelland; and U.S. Patent No. 5,918,022 ("Batz"). Claim 8 stands rejected under § 103(a) as obvious over Tyler; McClelland; Batz; and U.S. Patent No. 5,689,664 ("Narayanan"). Claim 10 stands rejected under § 103(a) as obvious over Tyler; McClelland; Batz; and Adunuthula. Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween.

II. INDEFINITENESS OF CLAIMS 1-23

"[N]ot[ing] that claim 1 recites a 'product rate calculation system' in its preamble, but only recites three elements in its body, namely a 'product application', a 'first support software component' and a 'first protocol stack,'" (Answer¹ 17), the Examiner asserts, "It is unclear as to which element performs the 'rate calculation' function recited in the preamble." (*Id.*)

¹ We rely on and refer to the Substitute Examiner's Answer in lieu of the original Examiner's Answer because the latter was defective. We will not consider the original in deciding this appeal.

The Appellant argues that "the Examiner has provided no specific indication of the elements omitted by the claim, and more importantly the Examiner has provided no rationale for considering the omitted elements critical or essential." (Br.² 5.)

"[N]ot[ing] that claim 16 recites a 'method calculating a product rate' in its preamble, but recites six steps in its body, namely 'receiving a request', 'converting the request.., into a call', 'sending the call', 'receiving the call,' 'processing the call . . . into a protocol for transmission', and 'transmitting the call,'" (Answer 18), the Examiner similarly asserts, "It is unclear as to which step performs the 'calculating product rate' function recited in the preamble." (*Id.*) The Appellant argues "that the Examiner[] . . . fails to identify the purported missing steps and fails to identify the rationale for considering those steps essential." (Br. 7.) Therefore, the issue is whether Examiner has shown that the preambles of claims 1 and 16 make these claims indefinite.

"The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991)). "A claim need not claim every function of a working device. Rather, a claim may specify improvements in one function without

² We rely on and refer to the Revised Supplemental Appeal Brief, in lieu of the Supplemental Appeal Brief and the Appeal Brief, because the latter were defective. We will not consider the latter in deciding this appeal.

claiming the entire machine with its many functions." *Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303, 50 USPQ2d 1429, 1435 (Fed. Cir. 1999).

Here, claims 1 and 16 reasonably apprise those of skill in the art of their scope, viz., generating or sending a call to a product rate calculation software component. Despite their preambles, the claims need not specify how rates are calculated. Therefore, we reverse the indefiniteness rejection of claims 1-23.

III. OBVIOUSNESS OF CLAIMS 1-15

The Examiner finds, "Tyler teaches . . . a product application operable to provide product information to and receive consumer information from a user (Tyler; column 5, lines 32-41). . ." (Answer 6.) She adds the following explanation.

In particular, in the passage repeatedly referred to by the Examiner, column 11, lines 33-36, Tyler states:

"API Layer 14 allows the Calculation Engine 16 to be called by multiple applications (i.e., consumer applications which do not employ object oriented technologies) to input and/or retrieve data into and from the Calculation Engine 16" (emphasis added).

(Answer 21-22.)

The Appellant argues "that none of the things to which the Examiner refers as teaching the claimed product application are operable to call Calculation Engine 16." (Br. 10.) Therefore, the issue is whether the Examiner has shown that teachings from the references would have suggested a product application to send a call to a product rate calculation software component.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933, 69 USPQ2d 1283, 1286 (Fed.Cir. 2003) (internal citations omitted).

A. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations: "a product application operable to provide product information to and receive consumer information from a user, and further operable to send a call to a product rate calculation software component . . ." Considering all the limitations, the independent claim requires a product application to send a call to a product rate calculation software component.

B. OBVIOUSNESS ANALYSIS

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)

(citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Tyler discloses "a computer-based system and method for requesting and inputting insurance and investment product information, and for performing calculations relevant to all aspects of insurance and investment products." (Col. 4, l. 65 – col. 5, l. 1.) More specifically, "[t]he system comprises the Design Grid 10 and the Calculation Engine 16. Application programming interfaces, hereinafter called an 'API', enables communication between components of the present invention." (Col. 10, l. 67 – col. 11, l. 4.)

"The Design Grid 10 is used to collect from a user the data and information required by the Calculation Engine 16 to generate a proposal." (Col. 11, ll. 11-13.) The Examiner reads the claim's "product application" on the reference's Design Grid. (Answer 6.)

For its part, the reference explains, "Once valid information is entered at the Design Grid 10, API Layer 12 communicates the information to API Layer 14 of the Calculation Engine 16." (Col. 11, ll. 22-24.) "API Layer 14 allows the Calculation Engine 16 to be called by multiple applications (i.e.,

consumer applications which do not employ object oriented technologies) to input and/or retrieve data into and from the Calculation Engine 16." (*Id.* ll. 33-36.) The Examiner reads the claim's "call to a product rate calculation software component" on Tyler's call to the Calculation Engine.

Although the Calculation Engine can be "called by multiple applications (i.e., consumer applications which do not employ object oriented technologies)," (*id.* ll. 34-35), the Examiner does not allege, let alone show, that the Design Grid is one on the applications that calls the Calculation Engine. For its part, the reference describes the Design Grid as "communicat[ing]" (*id.* l. 23), information to the Calculation Engine (via API Layer 12 and API Layer 14). Again, the Examiner does not allege, let alone show, that the reference's communicating is tantamount to the claim's calling. We interpret a call to be more than a mere communication of information. For example, a call may be "[t]he action of bringing a computer program, a routing, or a subroutine into effect, usually be specifying the entry conditions and jumping to an entry point." *IBM Dictionary of Computing* 82 (10th ed. 1993).

The Examiner does not allege, let alone show, that the addition of McClelland, Batz, Adunuthula, or Narayanan cures the aforementioned deficiency of Tyler. Absent a teaching or suggestion of a product application sending a call to a product rate calculation software component, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we

reverse the rejection of claim 1 and those of claims 2-15, which depend therefrom.

IV. OBVIOUSNESS OF CLAIMS 16-23

The Examiner asserts, "Tyler teaches . . . converting the request for a product rate into a call to a product rate calculation software component (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36). . . ."

(Answer 9.) The Appellant "notes that the cited portion of Tyler does not teach or suggest *converting the request* for a product rate *into a call to a product rate calculation software component.*" (Br. 17.) Therefore, the issue is whether the Examiner has shown that teachings from the references would have suggested converting a request for a product rate into a call to a product rate calculation software component.

A. CLAIM CONSTRUCTION

Here, claim 16 recites in pertinent part the following limitations: "converting the request for a product rate into a call to a product rate calculation software component. . . ." Considering all the limitations, the independent claim requires converting a request for a product rate into a call to a product rate calculation software component.

B. OBVIOUSNESS ANALYSIS

The first passage of Tyler cited by the Examiner explains that the reference's calculation engine "perform[s] all required calculations related to

insurance products." (Col. 5, ll. 12-13.) "These calculations include determining the cash value of a policy, calculating a death benefit on an annual basis, calculating the premium due, calculating the net premium due, determining a guaranteed cash value of all individual coverages, calculating annual cash dividends, and the like." (*Id.* ll. 13-18.) Converting a request for a product rate into a call to a product rate calculation software component, however, is not one of the calculations performed by the calculation engine.

The second passage of Tyler cited by the Examiner explains that the "API Layer 14 allows the Calculation Engine 16 to be called by multiple applications (i.e., consumer applications which do not employ object oriented technologies) to input and/or retrieve data into and from the Calculation Engine 16." (Col. 11, ll. 33-36.) Although the Calculation Engine can be called, the Examiner does not show that a request for a product rate is converted into such a call.

The Examiner does not allege, let alone show, that the addition of McClelland cures the aforementioned deficiency of Tyler. Absent a teaching or suggestion of converting a request for a product rate into a call to a product rate calculation software component, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 16 and those of claims 17-23, which depend therefrom.

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V. ORDER

In summary, the rejection of claims 1-23 is reversed.

REVERSED

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